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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,500	08/30/2001	Leonard Forbes	1303.029US1	3505

7590

12/24/2002

Schwegman, Lundberg, Woessner & Kluth, P.A.  
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EXAMINER

PHAM, LY D

ART UNIT PAPER NUMBER

2818

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/945,500

Applicant(s)

FORBES, LEONARD

Examiner

Ly D Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) 1-58, 70-76 and 88-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 59-69 and 77-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 1 – 58, 70 – 76, and 88 – 98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 59 – 69 and 77 – 87 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 42 – 50 and 58 – 66 of co-pending Application No. 09/945,498. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Referring to claims 59 and 77, claims 42 and 58 of Application No. 09/945,498 disclose an electronic system, comprising a processor; and a memory device coupled to the processor, wherein the memory device includes an array of DEAPROM memory cells, comprising: a

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number of pillars extending outwardly from a substrate, ....; and wherein ... adjacent pillars on opposing sides of the trench.

Although the co-pending application did not claim the programmable decoder with the limitations set forth as disclosed in the claim: a number of address lines; ...; a number of logic cells formed at the intersections of output lines and address lines.... However, in the memory art, the additional features as claimed are considered inherent for any electronic system, i.e. address lines, output lines, memory cells formed at the intersections..., in which, when utilized to couple to a processor, for information storage and retrieval purposes.

As for the features of the logic cells, hereinafter interpreted as memory cells, the limitations as claimed in claims 59 and 77 are equivalently to claims 42 and 58 in application no. 09/945,498.

With respect to claims 60 – 69 and 78 – 87, in order to provide a suitable intended use in the claimed electronic system and method for forming an in service programmable logic array, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select known available materials and features from the allowed claims 42 – 50 and 58 – 66 of co-pending Application No. 09/945,498.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

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4. When responding to the office action, Applicant(s) are advised to provide the examiner with the page and line numbers in the application and/or references cited to assist the examiner to locate the appropriate paragraphs.

5. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) day from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02(b)).

6. Any inquiry concerning this communication on earlier communications from the examiner should be directed to Ly Pham, whose telephone number is 703-305-4862. The examiner can normally be reached on Monday – Friday from 8:30am to 5:00pm, alternate Friday off. The examiner's supervisor, David Nelms, can be reached at 703-308-4910. The fax number for the organization where this application or proceeding is assigned is 703-308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Ly Pham



December 18, 2002

  
**HOAI HO**  
**PRIMARY EXAMINER**